

Response to Office Action mailed August 24, 2007

U.S. Appl. No. 10/796,239

Art Unit 3735 – Attorney Docket 1512.166

Page 8

**Amendments to the Drawings:**

The attached sheet of drawings includes newly added Fig. 9.

Attachment: New Sheet

Response to Office Action mailed August 24, 2007  
U.S. Appl. No. 10/796,239  
Art Unit 3735 – Attorney Docket 1512.166  
Page 9

## **REMARKS**

In the specification, paragraphs [0026], [0027] and [0043] have been amended in light of newly added drawing FIG. 9. The new paragraph [0027.1], added after paragraph [0027], has been added and merely describes the newly added drawing, FIG. 9.

In the drawings, FIG. 9 has been added in order to comply with the Examiner's objection thereto. No new matter has been added.

Claims 1-27 are currently pending. Claims 10-12 and 14-15 are now canceled. Claims 1, 5, 13, 16 and 23 are presently amended. Entry of the amendments and an indication of allowance in light of the amendments and the following remarks are respectfully requested.

### **1. Claim Numbering**

As noted by the Examiner in the Office Action, the claims, as originally filed, were not in accordance with 37 CFR 1.126. Applicant has renumbered claims 26-30 as 23-27 respectively, as directed by the Examiner.

### **2. Objections to the Drawings**

The Examiner has objected to the drawings under 37 CFR. 1.83(a). Further, the Examiner has requested that corrected drawing sheets be submitted under 37 CFR 1.121(d) to avoid abandonment of the application. Specifically, the Examiner has indicated that the drawings fail to show every feature of the invention specified by the claims. In particular, the Examiner has indicated that the drawings fail to show a "kit comprising at least two electrode assemblies, wherein the axial and radial distance of each electrode assembly is selected for ablating a tumor of a selected volume" and "the radial distance of each electrode assembly is less than four times the axial distance."

Figure 9 has been added to the drawings and is attached as an appendix hereto. Figure 9 illustrates "a kit comprising at least two electrode assemblies . . ." as required by the Examiner.

Further, as the kit was claimed as part of the original application, the addition of Figure 9 does not constitute the introduction of new matter. Accordingly, the Examiner's objection to the drawings for failing to show a "kit comprising at least two electrode assemblies, wherein the axial and radial distance of each electrode assembly is selected for ablating a tumor of a selected volume" is believed to be obviated, and as such, an indication to that effect is respectfully requested.

With respect to the Examiner's objection to the drawings for failure to show "the radial distance of each electrode assembly is less than four times the axial distance," Applicant submits that Fig. 4 of the drawings and paragraph [0032] of the published application, illustrate and describe respectively, the aforementioned limitations. Although, as patent drawings are not generally to scale Fig. 4 additionally illustrates "the radial distance of each electrode assembly [that] is less than four times the axial distance." *See* MPEP §2125. Accordingly, the Examiner's objection to the drawings is improper, and an indication to that effect is hereby respectfully requested.

### 3. Rejections Based on the Prior Art

The Examiner has rejected claims 1-3, 5-11, 14 and 15 under 35 U.S.C. §102(b) as being anticipated by Gough et al. (U.S. Patent No. 5,728,143). Claims 10-11 and 14-15 are now canceled. Claim 1 is currently amended to obviate the Examiner's rejection thereof.

Claim 1 has now been amended to further recite the step of "(a) inserting a support shaft through the patient's skin, the support shaft having an electrically insulated cover on an outer surface of the support shaft between a first position and a second position and extending to a distal tip of the support shaft . . ."

While Gough does teach the use of an insulating sleeve 18 on trocar 14, it does not, however, disclose the newly added limitation of an electrically insulated cover positioned between a first position and a second position, i.e., between the first plurality

Response to Office Action mailed August 24, 2007  
U.S. Appl. No. 10/796,239  
Art Unit 3735 – Attorney Docket 1512.166  
Page 11

and the second plurality of electrode wires. Accordingly, the amendments to claim 1 serve to obviate the Examiner's rejection of claim 1 and claims 2-3 and 5-9, which depend therefrom.

Further, modifying the invention disclosed in Gough in this manner would not have been obvious to one of ordinary skill in the art. The addition of insulation on the support shaft of the present invention serves to prevent the convergence of the electrical fields toward the support shaft between the two umbrella electrodes. The insulative coating serves to ensure that the current flow occurs between the electrodes rather than the electrode and the shaft. Gough, however, does not recognize this particular problem. Rather, Gough clearly shows the presence of an insulative sleeve, however, the sleeve is disposed at an end of the trocar, not positioned in between the electrodes. Thus, while Gough recognizes the advantage of including insulation on a portion of the trocar, it does not, however, aim to solve the same problem as the present invention. Namely, Gough fails to recognize that it would be advantageous to position insulation between the electrodes despite recognizing that the use of an insulative sleeve is otherwise advantageous. As such, it would not have been obvious to one of ordinary skill in the art to modify Gough to recite the newly-added limitations of now-amended claim 1. Therefore, it is believed that the amendments place claims 1-3 and 5-9 in condition for allowance and an indication to that effect is respectfully requested.

The Examiner has rejected claims 4, 12, 13 and 16-27 under 35 U.S.C. §103(a) as being unpatentable over Gough et al. in combination with Swanson et al. (U.S. Patent No. 6,488,679). Claim 12 is now canceled. In light of the amendments to claims 1, 13 and 16, it is believed that the Examiner's rejection is obviated.

In particular, as noted previously, claim 1 has been amended to further recite the limitation of a support shaft having an electrically insulated cover positioned between the first and second positions on the support shaft. Neither Gough nor Swanson discloses

Response to Office Action mailed August 24, 2007  
U.S. Appl. No. 10/796,239  
Art Unit 3735 – Attorney Docket 1512.166  
Page 12

such a limitation. As such, the combination thereof fails to recite each and every limitation of independent claim 1. Accordingly, the combination of Gough and Swanson likewise does not recite each and every limitation of dependent claim 4. As such, the Examiner's rejection of claim 4 is obviated by the Applicant's amendment of claim 1. An indication to that effect is hereby respectfully requested.

Claim 13 is now amended to depend from claim 3. As noted previously, claim 3 is believed to be in condition for allowance by virtue of its dependency on presently amended claim 1. Accordingly, claim 13 is believed to likewise be in condition for allowance, and an indication thereof is respectfully requested.

Claims 16-27 are similarly believed to be in condition for allowance. Claims 16 and 23 are presently amended to further recite the limitation of a support shaft having an electrically insulated cover disposed between the electrodes. As noted previously, Gough does not disclose such a limitation nor would it have been obvious to modify Gough to include such a limitation. Further, also noted previously, the combination of Gough and Swanson fails to recite each and every limitation of the amended claims 16 and 23. As such, claims 16 and 23 as well as those claims which depend therefrom are believed to now be in condition for allowance. An indication thereof is hereby respectfully requested.

#### **4. Conclusion**

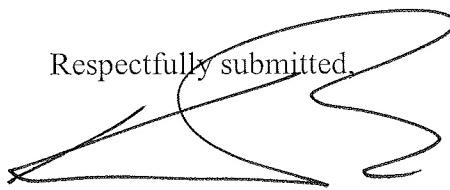
It is submitted that claims 1-9, 13 and 16-27 define patentable subject matter. A Notice of Allowance is therefore respectfully requested.

Should the examiner consider any other fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Response to Office Action mailed August 24, 2007  
U.S. Appl. No. 10/796,239  
Art Unit 3735 – Attorney Docket 1512.166  
Page 13

The examiner is invited to contact the undersigned by telephone if it would help expedite matters.

Respectfully submitted,



Keith M. Baxter  
Registration No. 31,233

Date: November 21 2007  
Customer Account No.: 23598

BOYLE FREDRICKSON, S.C.  
840 North Plankinton Avenue  
Milwaukee, WI 53203  
Telephone: (414) 225-9755  
Facsimile: (414) 225-9753